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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 10.03.2003				
Daniel A. Scola, Jr. HOFFMANN & BARON, LLP 6900 Jericho Turnpike Syosset, NY 11791				
EXAMINER SERGEANT, RABON A				
ART UNIT		PAPER NUMBER		
1711				

DATE MAILED: 10.03.2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

Applicant(s)

10/081,564

KADZIELA ET AL.

Office Action Summary

Examiner

Art Unit

Rabon, Sergeant

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. ____.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

Office Action Summary

- 1) ☐ Notice of Draftperson's Patent Drawing Review (PTO-3448)
- 2) ☐ Notice of Informal Patent Application (PTO-1521)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper Not(s)

- 4) ☐ Other
- 5) ☐ Other
- 6) ☐ Other

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1. Claims 1-22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1 and 19, it is unclear what constitutes a "cure system".

Within claims 2-5, it is unclear if the structures of the recited di-functional and mono-functional monomers contain urethane groups. It is unclear if the urethane acrylate oligomer comprises non-urethane components.

Within claims 2-5, 16, and 17, applicants have failed to set forth a basis for the claimed weight percents.

Within claim 7, the use of "based" renders the claim indefinite, because it is unclear to what extent or how the aliphatic urethane-acrylate is "based" upon or derived from polyester.

Based on the contradiction between the weight percent recited in claim 17 and the weight percent recited in claim 16, it is unclear if the 2(2-ethoxyethoxy)-ethyl acrylate is present with other components that function as (c).

Within claim 20, it is unclear what constitutes a "desired" thickness. What criteria must be considered in order to determine that the thickness is "desired"?

Within claim 24, the language, "said soft tip", lacks antecedent basis.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 6-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Huynh-Tran et al. ('712).

Patentees disclose elastomeric compositions having Shore A hardness values below 55 (see examples), wherein the composition comprises the reaction product of a urethane polyacrylate (abstract), a reactive diluent, such as isobornyl acrylate (column 12, line 28), and a

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moldable. Furthermore, patentees disclose quantitative ranges of components that meet those claimed by applicants. See column 14, lines 4-12.


4. Claims 19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. ('007) in view of Huynh-Tran et al. ('712).

Ward et al. disclose a soft tip for use with a hearing aid, wherein patentees disclose that the tip is constructed of a flexible material, such as soft acrylic. See column 5, lines 37-39.

5. Though Ward et al. disclose that the tip may be made from a soft acrylic material, Ward et al. fail to disclose the use of a urethane acrylate material that corresponds to that claimed by applicant. However, as aforementioned within paragraph 3, Huynh-Tran et al. disclose urethane acrylate materials that are moldable or castable and have low Shore A hardness values.

Furthermore, the materials of Huynh-Tran et al. correspond to those claimed. Given that Ward et al. disclose that soft acrylic materials may be used to construct the tip, the position is taken that one would have been motivated to construct the tip from the soft urethane acrylate material of Huynh-Tran et al.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent